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10/075,183	02/14/2002	Yoshiaki Wani	09792909-5341	7271

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EXAMINER

CANTELMO, GREGG

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 11/19/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/075,183

Applicant(s)

WANI ET AL.

Examiner

Gregg Cantelmo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Preliminary Amendment***

1. The preliminary amendment received February 14 2002 has been entered.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
4. No IDS appears to have been filed with the application prior to this office action.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: projection trains 56A as recited on page 7, line 10 is not shown in any of the

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figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4)

because:

- a. Reference characters "128" and "120" have both been used to designate the body of the casing in Fig. 3;
- b. Reference characters "16A" and "16" and "20" all have lead lines which terminate at the body of the casing in Figs. 1 and 4.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. The abstract of the disclosure is objected to because it exceeds 150 words. A 150-word limit has been imposed by the USPTO to conform to PCT applications and Pre-Grant Publications. See 37 CFR 1.72 and rule changes applied thereto. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

8. Claim 2 is objected to because of the following informalities:
- a. Claim 2 recites both body portions of the main body and lid (plural body portions). Thus the subsequent cross-sections are plural as well. Thus the phrase "is shaped" should be --are shaped-- since this shape is drawn to both body portions and thus represents more than one cross-section shape;
  - b. Commas should be inserted in claim 6 after "projection portion" in line 3 and after "lid portion" in line 5.
- Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent No. Des. 433,562 (Redlinger) in view of U.S. patent No. 4,298,036 (Horvath).

The instant claims do not provide sufficient structure to limit the function of the case for only holding batteries. The claims have been given their broadest reasonable interpretation to be any casing having the same structure recited in the instant claims. For example, the applied art here are drawn to cosmetic cases. However in terms of

the claimed structure, the combination is held to render the instant claims case structure obvious. See MPEP § 2114 and § 2111.02, incorporated herein.

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction.

Redlinger discloses a storage case including a main body having a body portion, an opening portion of one end of said body portion and a bottom surface of the other end of said body portion and a lid portion having a body portion, an opening portion of one end of said body portion and a head portion of the other end of said body portion, said battery storage case comprising a through-hole bored through the head portion of said lid portion, wherein a circumference portion of at least one opening portion of said through-hole is shaped like a concave portion and a part of the circumference of said through-hole is shaped like a cylindrical portion (Figs. 1-3 as applied to claim 1).

The body portion of said main body and said body portion of said lid portion have cross-sections at least a part of which is shaped like a circular arc (Figs. 1-3 as applied to claim 2).

The body portion of said main body and said body portion of said lid portion have circular cross-section (Figs. 1-3 as applied to claim 3).

The bottom of the case is expanded toward the outside via the rotating end component for moving the lip balm. Claim 4 does not specify the degree or exact manner in which the base is extended (Figs. 1-3 as applied to claim 4).

The head portion has a space portion formed between the through-hole and body portion (Figs. 1-3 as applied to claim 5).

A projection portion of the body is stepped and at the base of the projection portion on the body is substantially the same diameter as the lid portion to form an effective contact between the body and cap (Fig. 1 as applied to claim 6).

The differences between claim 1 and Redlinger are that Redlinger does not explicitly teach of projection trains formed on an outer surface of said body portion of said main body or projections or projection trains formed on an inner surface of the body portion of said lid portion so as to be engaged with the projection trains of said main body (claim 1).

It is well known to use projections as a means of securing a cap or lid to a cylindrical housing as shown by Horvath (Fig. 2 and abstract).

The motivation for providing mating means on the cap and body as recited in claim 1 is that it provides a means for enhancing the securing of the body of the case to the lid thus preventing the body of the case from falling off of the lid.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Redlinger by providing mating means on the cap and body as recited in claim 1 since it would have provided a means for enhancing the securing of the body of the case to the lid thus prevented the body of the case from falling off of the lid.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. patent Nos. 3,306,266, 3,881,601, 4,087,015, 5,117,976, 5,318,177, 5,819,917, Des. 409,830 and Des. 341,227 disclose of similar case configurations.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (703) 305-0635. The examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (703) 308-2383. Note that these telephone numbers will change around January 1, 2004. At such time the examiners new telephone number will be (571) 272-1283 and the examiner's supervisors number will be (571) 272-1292. FAX communications should be sent to FAX number: (703)



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872-9306. FAXES received after 4 p.m. will not be processed until the following business day. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gregg Cantelmo  
Patent Examiner  
Art Unit 1745

gc

A handwritten signature in cursive script, appearing to read "Gregg Cantelmo".

November 16, 2003